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10/520,527	10/11/2005	Eberhard Schmid	ADV0001-US	9242
28970	7590	09/06/2007		
PILLSBURY WINTHROP SHAW PITTMAN LLP			EXAMINER	
P.O. BOX 10500			IP, SIKYIN	
MCLEAN, VA 22102				
			ART UNIT	PAPER NUMBER
			1742	
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			09/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter such as amended lower limit of P "0.011" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no literal support in the specification as original filed

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1742

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 3-6 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 6346215 to Boegel et al.

Claims 1 and 6 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5487867 to Singh.

Boegel discloses Cu based alloys containing Sn, Fe, Mn, Zn, and P (col. 5, lines 9-50) and the known uses of the Cu based alloys such as jewelry and clothing accessories (abstract) and eyeglass frame (col. 2, lines 1-21). Singh discloses Cu based alloys include Sn, Fe, Mn, Zn, and P (col. 3, lines 1-20). The claimed intermediate products have no structures which read on product as taught by cited references. As stated in *In re Peterson*, 315 F.3d 1325, 1329-30, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003), that "A prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art". Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

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The resilience property is recited in relative term not defined in measurable unit, which is possessed by all materials.

Response to Arguments

Applicant's arguments filed June 26, 2007 have been fully considered but they are not persuasive.

~~More particularly, Boegel does not disclose, teach, or suggest at least the feature of an alloy having a composition (in weight-percent) of "P 0.011 to 0.05 %" and "Fe 0.001 to 0.02 %,"~~

Applicants argue that "as recited in claim 1, for example. ~~Rather, Boegel indicates that "in the presence of iron high,"~~

But, applicants' attention is directed to Boegel (col. 5, lines 21-23) that "Iron can be partially or completely replaced in this alloy composition with cobalt." So iron content in Boegel is from 0 to 5 wt.% which overlaps the claimed "0.001 to 0.02 wt.%."

Applicants argue that

Furthermore, Singh does not disclose, teach, or suggest at least the feature of a "nickel-free alloy . . . having properties of resilience," as recited in claim 1, ~~for example. Rather, Singh~~ The resilience property is recited in relative term not defined in measurable unit, which would be possessed by all materials.

Conclusion

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).

Examiner Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip

September 4, 2007